

Remarks

The non-final Office Action dated October 21, 2008, indicated the following rejections and objections: claims 1, 3, 6-7, 9, 12-14, 16 and 19-20 were rejected under 35 U.S.C. § 102(e) over Tracy (U.S. Patent Pub. No. 2004/0252062); claims 2 and 8 were rejected under 35 U.S.C. § 103(a) over the '062 reference in view of Kadambi (U.S. Patent Pub. No. 2002/0140612); claims 4 and 10 were rejected under 35 U.S.C. § 103(a) over the '062 reference; claims 5, 11 and 21 were rejected under 35 U.S.C. § 103(a) over the '062 reference in view of Koskiniemi (U.S. Patent Pub. No. 2003/0098813); claims 15 and 17 were rejected under 35 U.S.C. § 103(a) over the '062 reference in view of Poilasne (U.S. Patent Pub. No. 2004/0095281); claim 18 was rejected under 35 U.S.C. § 103(a) over the '062 and '281 references and further in view of the '813 reference; an objection to the specification; an objection to the abstract; and an objection to the drawings under 37 C.F.R. § 1.83(a) for allegedly failing to show every feature of claim 18. Applicant respectfully traverses each of these objections and rejections and, unless explicitly stated by the Applicant, does not acquiesce to any objection, rejection or averment made in the Office Action.

Applicant respectfully traverses all of the § 102(e) and § 103(a) rejections presented in the instant Office Action (each of which is based on the '062 reference) because the '062 reference is not prior art to the claimed invention. Applicant submits that the claimed invention was conceived of prior to the filing date of the '062 reference (*i.e.*, June 13, 2003), as evidenced by the 37 C.F.R. § 1.131 Declaration submitted herewith, showing correspondence between the claimed invention and a document entitled "Multi-band RF Modules" dated before June 13, 2003. This § 1.131 Declaration has been executed by Kevin Boyle, the inventor of the subject matter of the claimed invention. Applicant notes that "(w)hen alleging that conception or a reduction to practice occurred prior to the effective date of the reference, the dates in the oath or declaration may be the actual dates or, if the applicant or patent owner does not desire to disclose his or her actual dates, he or she may merely allege that the acts referred to occurred prior to a specified date." *See*, M.P.E.P. § 715.07(II). Thus, since the attached § 1.131 Declaration alleges conception, Applicant has chosen to redact the dates in Exhibit A. In addition, Applicant submits that the claimed invention was pursued with due diligence (as evidenced by the attached § 1.131

Declaration) from prior to June 13, 2003 until its filing on July 10, 2003 as Great Britain Application Number 0316269.2 (*i.e.*, constructive reduction to practice). Therefore, Applicant submits that the '062 reference is not prior art under § 102(e) and, as such, the '062 reference is not prior art to the claimed invention. Accordingly, Applicant requests that all of the § 102(e) and § 103(a) rejections presented in the instant Office Action be withdrawn.

Applicant notes that a minor amendment has been made to various claims to replace "rf" with "RF." Applicant submits that this amendment is not being made to overcome any of the rejections presented in the instant Office Action, which fail for at least the reasons discussed above.

Applicant respectfully traverses the objection to the specification because the Examiner fails to present any basis (from the M.P.E.P. or otherwise) to support the assertion that the specification needs to be amended to include reference to PCT application No. PCT/IB04/02235. Applicant notes that M.P.E.P. § 1893.03(c) states that it is not necessary to amend the specification to include reference to such an application:

Note: a national stage application submitted under 35 U.S.C. 371 may not claim benefit of the filing date of the international application of which it is the national stage since its filing date is the **>international filing date of the< international application. See also M.P.E.P. § 1893.03(b). Stated differently, since the international application is not an earlier application (it has the same filing date as the national stage), a benefit claim under 35 U.S.C. 120 in the national stage to the international application is inappropriate and may result in the submission being treated as an application filed under 35 U.S.C. 111(a). See M.P.E.P. § 1893.03(a). Accordingly, it is not necessary for the applicant to amend the first sentence(s) of the specification to reference the international application number that was used to identify the application during international processing of the application by the international authorities prior to commencement of the national stage.

As such, Applicant declines to amend the specification at this time. Applicant would be willing to reconsider amending the specification to include reference to PCT application No. PCT/IB04/02235 should the Examiner provide a basis for requiring such an amendment.

In response to the objection to the Abstract, Applicant has provided an amended Abstract as discussed on page 5 of this paper. As such, Applicant requests that the objection to the Abstract be removed.

Applicant respectfully traverses the objection to the drawings. Applicant submits that the objection to the drawings is improper as it relies upon an improper interpretation of the U.S.P.T.O. rules. The sole support for the objection, 37 C.F.R. § 1.83(a), is directed to showing claimed features in the figures. The definition of a feature is a prominent attribute or aspect of something. The specific aspect identified as missing, while possibly relevant, is not a prominent attribute or aspect. Rather than limit the cited rule to prominent aspects of the claims, the Examiner appears to take the position that the figures must provide a near word-for-word correspondence to the claims. Applicant respectfully submits that the detailed, specific limitations related to the area between the feed and shorting pillars containing part of a bandwidth broadening resonant circuit (*see* claim 18) should not be interpreted as prominent attributes per 37 C.F.R. § 1.83(a). Applicant notes that Figure 2 clearly shows an area between feed pillar 24 and shorting pillar 22. Moreover, the Examiner's position, if applied to all cases, would ostensibly require that every patent application contain a near word-for-word replication of all language from the claims into the figures. Applicant's position is also supported by a number of U.S. laws, U.S.P.T.O. rules and passages of the M.P.E.P.. This support is largely inconsistent with the Examiner's position and will be discussed hereafter.

The Examiner's interpretation of 37 C.F.R. § 1.83(a) is contrary to the P.T.O. practice, U.S. law and the M.P.E.P.. In support of Applicant's position reference is made to 35 U.S.C. § 113 and M.P.E.P. § 601.01(f), which indicate that "applicant shall furnish a drawing where necessary for the understanding of the subject matter sought to be patented." The authority for the U.S.P.T.O. to create rules such as 37 C.F.R. § 1.83(a) is derived from 35 U.S.C. § 113. Accordingly, 37 C.F.R. § 1.83(a) must be interpreted in light of this law to ensure that the U.S.P.T.O. does not exceed the statutory authority granted by the U.S. Congress. Moreover, M.P.E.P. § 608.02(e) clarifies how 37 C.F.R. § 1.83(a) should be interpreted and applied by an examiner: "The drawings are objected to under 37 C.F.R. § 1.83(a) because they fail to show [1] as described in the specification. Any structural detail *that is essential for a proper understanding of the disclosed invention* should be shown in the drawing." (*emphasis added*). This language is the suggested paragraph for an examiner that wishes to use a 37 C.F.R. § 1.83(a) objection. Conveniently, the Examiner has not used this language, choosing instead to

ignore the second half of the suggested language. Applicant respectfully submits that illustration of a bandwidth broadening resonant circuit in the area between feed pillar 24 and shorting pillar 22 in Figure 2 is not essential for a proper understanding of the claimed invention. Accordingly, the objection to the drawings is improper and Applicant requests that it be removed.

In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance. Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is asked to contact the agent overseeing the application file, Aaron Waxler, of NXP Corporation at (408) 474-9068 (or the undersigned).

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Attachments:

§1.131 Declaration (2 pages) with Exhibit A (3 pages).